

REMARKS

This responds to the Office Action mailed on August 23, 2005, and the references cited therewith.

Claims 1 and 8 are amended. No claims are added or cancelled. Claims 1-4 and 8-11 remain pending in this application.

Information Disclosure Statement

Applicants submitted an Information Disclosure Statement and a 1449 Form on May 24, 2004. Applicants respectfully request that initialed copies of the 1449 Forms be returned to Applicant's Representatives to indicate that the cited references have been considered by the Examiner.

Double Patenting Rejection

Claims 1-4 and 8-11 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-13, 43 and 46-49 of co-pending Application No. 10/630,544.

Claims 1-4 and 8-11 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 6,607,599 (Jiang et al.) or claims 1-15 of U.S. Patent No. 6,599,365 (Jiang et al).

Claims 1-4 and 8-11 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-77 of U.S. Patent No. 6,669,781 (Jiang et al.) or claims 1-24 of U.S. Patent No. 6,641,669 (Jiang et al).

Applicants will submit a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) to obviate these rejections once the Patent Office withdraws the rejections under 35 U.S.C. § 102(b). It is respectfully submitted that requiring submission of Terminal Disclaimers now, when the allowable scope of those claims is still being determined, is premature.

§102 Rejection of the Claims

Claims 1-4 and 8-11 were rejected under 35 U.S.C. § 102(b)¹ for anticipation by Japanese Patent 59-76868. Applicants respectfully traverse the rejection for the reasons stated below.

Applicants respectfully traverse the rejection since not all of the recited elements of the rejected claims, as amended, are found in the cited Japanese patent.

The Office Action concedes that "Japan '868 is silent as to the obstruction of the flow of the printable material through the apertures..." but then goes on to conclude that as a consequence it "thereby reads on the negative limitation that the material flows without obstruction of the flow of printable material through the apertures." Applicant also notes that the cited Japanese patent does not show or suggest the use of a mask with a "printable adhesive" as required in each of claims 1-4 and 8-11; it merely indicates that it is "used in the formation of thin films on prescribed parts by spraying fine powder of metal, ceramics or the like." Applicants submit that the Office Action has the burden of showing that a fine powder of metal or ceramic would present the same spreading problems as the claimed printable adhesive and has not done so.

Applicants also observe that FIG. 2 of the Japanese patent shows two distinct layers 2a and 2b rather than "a coating" as called for in each of claims 1-4 and 8-11.

Finally, the cited Japanese patent fails to show or suggest that the a "layer of polymeric material" is used in that patent for any other purpose than assuring that, as stated in the Japanese patent, "no sprayed material deposits on the mask A." In contrast, amended claims 1 and 8 clearly state that the coating is applied *only* to the bottom surface of the sheet "to retard spreading of the printable adhesive material onto the bottom surface of the sheet..."

In view of the above it is clear that the Japanese patent lacks features called for in amended claims 1-4 and 8-11 so that the rejection stated in the Office Action does not make out a *prima facie* showing of anticipation.

Reconsideration and withdrawal of the rejection of claims 1-4 and 8-11 is respectfully requested.

¹ Applicants note the citation of the obviousness portion of the statute at page 5 of the Office Action but observe that only anticipation rejections were alluded to with any specificity.

Claims 1-4 and 8-11 were rejected under 35 U.S.C. § 102(b) for anticipation by Pryor et al. (U.S. Patent No. 4,269,874). Applicants respectfully traverse the rejection for the reasons stated below.

Pryor relates to a rotating disk 20 having several stencil openings representing characters to be formed by the stencil. The patent states² that "A rotating teflon or other non-stick coated aluminum stencil disc 20 is provided having stencil characters 26 cut through the disc around its periphery as shown in FIG. 2." The disc is spun at a high speed so that ink on the surface is "spun-off"³ The Office Action does not state where in Pryor there is shown "a coating applied *only*⁴ to a bottom surface of the sheet to retard spreading of the printable adhesive onto the at least one bottom surface of the sheet" as amended claim 1 now requires.

Actually, Pryor relies upon the Teflon coating to facilitate the movement of ink across the disk surface to remove it as the structure spins. In amended claims 1 and 8, the coating is applied only to the bottom surface "to retard" spreading of the adhesive material across the surface. Thus the Office Action fails to show that a coating which is applied *only* to the bottom surface "to retard spreading" as claimed in claims 1 and 8 is anticipated by the fully coated disk of Pryor.

In view of the above it is clear that Pryor lacks features called for in amended claims 1-4 and 8-11 so that the rejection stated in the Office Action does not make out a *prima facie* showing of anticipation.

Reconsideration and withdrawal of the rejection of claims 1-4 and 8-11 is respectfully requested.

² U.S. Patent 4,269,874 to Pryor, Col. 3, lines 18-23.

³ Op cit Col 5, lines 18-20.

⁴ Emphasis added.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6970 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date January 23, 2006

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23 day of January, 2006.

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